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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/599,493 | 09/29/2006 | Stjepan Radmanic | 31329/DP1346 | 9766 |
| 4743 | 7590 | 11/20/2008 | EXAMINER | |
| MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606 | | | | PEDDER, DENNIS H |
| 3612 | | ART UNIT | | PAPER NUMBER |
| 11/20/2008 | | MAIL DATE | | DELIVERY MODE |
| | | | | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/599,493 | RADMANIC ET AL. | |
| | Examiner | Art Unit | |
| | Dennis H. Pedder | 3612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 November 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-17 and 19-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 14-17 and 19-40 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 06 November 2008 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The applicant is thanked for the clarification of the independent claim limitation relative to the "area that receives at least a portion of the seal". The clarification is made more than two years after filing of this application, a condition not amenable to compact prosecution. As a result of the amendment, the claims have been re-examined and new rejections follow.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the projection comprises foam, claim 23, 35 the projection is integrated into a peripheral edge and comprises foam, claim 24, 36 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant's remarks are noted. The cross hatching in the figures is that of metal. See MPEP 608.02 for correct hatching for synthetic material. In addition, a projection on the outer surface of a roof element is not "integrated into".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. These claims are not understood. The contact between the roof element and the interfering body is virtually identical in the prior art of figure 4 and applicant's invention of figure 3. Applicant discloses that the contact produces sliding in the prior art, but claims prevention of such sliding in the invention. No structure or means are disclosed to yield this result.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19-21 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 19, 31 are confusing in that it does not limit the front edge projection of claim 14, 27. The claims are also rejected under 35 USC 112, fourth paragraph as not limiting the previous claim. Claims 20-21 and 32-33 are rejected as depending on these confusing claims.

9. Claims 14-17, 19-40 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The frame of reference for the physical relationship between the movable roof element and the interfering body is necessary to make sense of the function "contacts an interfering body that is present between the frame component and the movable roof element before the roof element engages the seal element". For example, suppose the interfering body is a stone in the depression 35 of applicant. The stone is of a small height smaller than the seal 36. The function listed in claim 1 would not be present even in applicant's disclosed invention.

11. Claims 39 and 40 similarly lack a clear frame of reference. Applicant's figure 3 shows both acute and obtuse angles relative to the end motion 42 of the roof element and the surface of the interfering body, as does the prior art.

Specification

12. The disclosure is objected to because of the following informalities: The amendment of 11/6/2008 to paragraph 26 does not appear to correspond to any previous paragraph per Rule 121.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 14-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuermann et al.

16. The projection is at “1A”. The seal element is affixed to the frame 3. This projection has multiple angles and extends from the front edge in a closing direction and receives a portion of the seal. Note figure 3 wherein the seal extends vertically below the upper edge of the roof frame 3. Therefore, the projection is capable of contacting an interfering body prior to seal engagement, dependent, as is applicant’ interfering body, on the angled presentation of the interfering body to the roof frame and seal. As to projection is part of the roof element, the seal is received by both.

17. As to claim 15, note figures 2 and 1.
18. As to claim 16, see figure 2.
19. As to claim 17, see figure 3.
20. As to claims 19 and 20, the projection 1A extends from the front edge and continues downwardly.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 14-17, 19-21, 25, 27-33,37 are rejected under 35 U.S.C. 102(b) as being anticipated by Igel.
23. Igel has roof opening front edge, movable roof element 3, angled projection 20, body mounted frame component 2, seal element 18, and movable roof element receiving a portion of the seal as seen in figures 2 and 3. The projection 20 is capable of receiving an interfering body at the height of the component 2 and extending into the area through which the projection 20 extends upon closing well before seal engagement, just as that of applicant.
24. As to claim 15, the roof element moves downwardly.
25. As to claim 16, the roof element is hinged to move in an arcuate manner.
26. As to claim 27, the component 2 defines a depression in front of and below the seal.
27. As to claims 25 and 37, the projection of Igel is well able to engage a 4mm interfering body.

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28. Claims 22-23, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igel in view of Schmidhuber et al.

29. Applicant has challenged, for the official record, the prior statements of judicial notice relative to claims 22-24 and 26.

30. With regard to claims 22-23, 34-35, Schmidhuber et al. teach that an edge foaming (see col. 2, line 1) may extend around the entire periphery of the roof element, including the front edge.

31. It would have been obvious to one of ordinary skill to provide in Igel the edge projection extent and material as taught by Schmidhuber et al. as a known structure in this art in order to protect the edge of the roof element.

32. Claims 24, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igel in view of Schmidhuber et al. as applied to claim 23, 35 above and further in view of Boersma et al. It would have been obvious to one of ordinary skill to provide in the references above an edge projection that is "integrated into the edge of the roof element" as taught by Boersma et al. in order to better bond the edge projection, see col. 3, lines 23-25.

33. Claims 25, 37, 39 and 40 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Igel.

34. The size of the projection is not a patentable distinction but an obvious expedient to one of ordinary skill in the art, claims 25, 37.

35. As to claims 39 and 40, Igel is fully capable of forming an obtuse angle with an interfering body that is between the projection and frame component.

36. Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igel in view of Lamm et al. .

37. Lamm et al. teach that a roof element drive may have a monitor 24 coupled to the drive and that it is known in this art to use parameters such as current, torque, revolutions and speed to effect safety by reversing or stopping the motor drive.

38. It would have been obvious to one of ordinary skill to provide in Igel the drive control as taught by Lamm et al. in order to affect safety.

Response to Arguments

39. Applicant's arguments filed 11/6/2008 have been fully considered but they are not persuasive.

40. Applicant's distinction between "receive" and "engage" is obtuse (section VI). Applicant offers no definition and the distinction is not understood.

41. Remaining arguments are responded to above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (571) 272-6667. The examiner can normally be reached on 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis H. Pedder/
Primary Examiner, Art Unit 3612

Dennis H. Pedder
Primary Examiner
Art Unit 3612

DHP
11/18/2008